REMARKS

Claims 1-17 are pending in this application. Claim 1 is the only independent claim. By this amendment, claims 1, 8-10 and 13-15 are amended. Reconsideration in view of the above amendments and following remarks is respectfully solicited.

I. THE CLAIMS SATISFY THE REQUIREMENTS OF 35 U.S.C. §112, 2nd PARAGRAPH

The Office Action rejects claims 8-10 and 14-16 under 35 U.S.C. §112, 2nd paragraph. The Office action also objects to claim 13 for minor informalities contained therein. The rejection and objection are respectfully traversed.

Applicant respectfully submits that the amendment to claims 8-10 and 14-15 obviates the rejection of claim 8-10 and 14-16 under 35 U.S.C. §112, 2nd paragraph. In particular, the claims are amended to provide proper antecedent basis. In addition, the amendment to claim 13 obviates the objection.

Accordingly, withdrawal of the rejection of claims 8-10 and 14-16 under 35 U.S.C. §112, 2nd paragraph and withdrawal of the objection to claim 13 is respectfully solicited.

II. THE CLAIMS DEFINE PATENTABLE SUBJECT MATTER

The Office Action rejects: **(1)** claims 1, 2, 12 and 17 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,475,509 to Okamoto (hereafter Okamoto); **(2)** claims 3-5 and 7 under 35 U.S.C. §103(a) as being unpatentable over Okamoto in view of U.S. Patent No. 6,188,432 to Ejima (hereafter Ejima); **(3)** claims 6 and 11 under 35 U.S.C. §103(a) as being unpatentable over Okamoto in view of U.S. Patent No. 4,973,149 to Hutchinson (hereafter Hutchinson); **(4)** claims 8-9 and 14-15 under 35 U.S.C.

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§103(a) as being unpatentable over Okamoto in view of Japanese Patent 407074943A to Nakamura; and **(5)** claims 10, 13 and 16 under 35 U.S.C. §103(a) as being unpatentable over Okamoto in view of Ejima and further in view of Nakamura. These rejections are respectfully traversed.

Applicant respectfully submits that Okamoto fails to teach or suggest each and every feature as set forth in the claimed invention. In particular, Okamoto at least fails to teach or suggest setting image processing conditions based on the at least one principal part of the image designated, as set forth in independent claim 1.

Claim 1 recites, *inter alia,* image processing means for performing necessary image processing on the received image data to produce output image data. Display means displays an image carried by the image data supplied from the source of image data supply. Designating means designates at least one principal part of the image displayed by the display means. Setting means sets image processing conditions in accordance with information about the at least one principal part of the image designated. The image processing means performs the necessary image processing under the image processing conditions set by the setting means.

For example, in the claimed invention a setting subsection 66 selects what image processing should be executed and sets the relevant image processing conditions. Prescanned data is read from the prescan memory 40 and processed under the thus set image processing conditions. The processed prescanned data is then displayed on the display 20. Looking at the displayed data, the operator designates a point in the principal part of the image on the display. The conditions setting section receives information about the region of the principal part and sets image processing

conditions or calculates the amount of adjustments from the previously set conditions in accordance with the image data for the designated principal part.

In contrast to the present invention, Okamoto discloses that first a particular point to be corrected in the image data is specified and finishing requirements are specified. Secondly, Okamoto processes the image data at the specified point under predetermined image processing conditions to obtain processed image data. Lastly, Okamoto compares the processed image data with target processed data to revise the image processing conditions based on the result of the comparison. (see Okamoto, col. 1, lines 50-64). In other words, Okamoto discloses that the image processing conditions are corrected based on the result of the comparison made by comparing the processed image data (image data at the specified points under predetermined conditions) with target processed data (data that meets the finishing requirements). Thus, Okamoto sets corrected image processing conditions by using both predetermined processing conditions and inputted finishing requirements.

However, in the claimed invention, corrected conditions are set in accordance with information about the principal part of the image designated. However, Okamoto requires that both the process image data and the finishing requirements must be looked at and compared. The additional step of comparing such data in Okamoto also adds to the processing time.

Furthermore, even if Okamoto discloses specifying means for specifying one point to be corrected and discloses specifying finishing at the specified point, Okamoto's display screen must be switched to the "finishing requirements" screen on the display (see Fig. 5 of Okamoto). In Okamoto, an image to be processed is displayed in the screen, one point thereof is specified by an

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operator with the specifying means, and the operator selects and specifies an instruction suitable for the specified point from various instructions for "finishing requirements" displayed on the screen.

Accordingly, Okamoto requires an operator to select an instruction suitable for the specified point from "finishing requirements" by the specifying means, but selection of an instruction best suitable for the specified point from "finishing requirements" can only be done by a skilled operator to yield an effective result.

In addition, Okamoto requires two specifying steps, one is to specify one point and the other is to specify one instruction from "finishing requirements", before setting an instruction of "finishing requirements" for the specified point.

Furthermore, an instruction from "finishing requirements" is specified for the specified point in Okamoto, but this does not means the step determines (sets) the image processing conditions suitable to process the specified point. Therefore, it is necessary in Okamoto to perform comparison between the target processing data for an instruction of "finishing requirements" and the actual processing data, and to bring the actual processing data close to the target processing data.

In contrast to Okamoto, in the present invention appropriate image processing conditions are automatically set in accordance with at least one principal part of the image designated by an operator who only specifies at least one principal part of the image displayed by the display means with the specifying means. Thus, the operator is required to neither select nor specify the image processing conditions suitable for the designated at least one principal part.

According to MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). The elements must be arranged as required by the claims, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicant respectfully submits that the Office Action has failed to establish the required *prima facie* case of anticipation because the cited reference, Okamoto, fails to teach or suggest each and every feature as set forth in the claimed invention.

Additionally, applicant notes that, in order to anticipate a "means-plus-function" clause as recited in independent claim 1, a reference must disclose a function identical to the recited function. Applicant respectfully submits that the Office Action is merely using portions of the claimed functions and is attempting to find the same function in the cited reference. However, the entire identical function must be disclosed.

Applicant respectfully submits that independent claim 1 is allowable over Okamoto for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1, 2, 12 and 17 under 35 U.S.C. §102(b) is respectfully solicited.

Applicant also respectfully submits that Ejima, Hutchinson and Nakamura all fail to make up for the deficiencies found in Okamoto.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Like Okamoto, Ejima, Hutchinson and Nakamura all fail to teach or suggest setting corrected image processing conditions based on the information about the at least one principal part of the image designated, as set forth in claim 1.

As such, applicant respectfully submits that the combination of Okamoto with either Ejima, Hutchinson or Nakamura fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicant also respectfully submits that not only does the combination of references fail to teach or suggest each and every feature as set forth in the claimed invention, but that one of ordinary skill in the art would not have been motivated to combine/modify the teachings of Okamoto with the other cited references because there is no teaching or suggestion in any of the references regarding how or why one would modify such systems to arrive at the claimed invention.

Applicant respectfully submits that dependent claims 3-11 and 13-16 are allowable over Okamoto in combination with either Ejima and/or Hutchinson and/or Nakamura for at least the reasons noted above.

Accordingly, withdrawal of the rejection of claims 3-11 and 13-16 under 35 U.S.C. §103(a) is respectfully solicited.

III. CONCLUSION

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Applicant respectfully petitions under the provisions of 37 C.F.R. §1.136(a) and §1.17 for a one (1) month extension of time in which to respond to the Examiner's Office Action. The appropriate Extension of Time Fee is attached hereto.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 **to schedule a Personal Interview**.
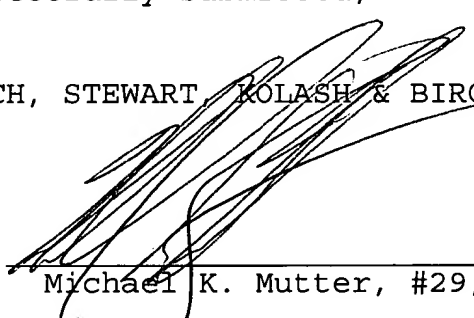
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Respectfully submitted,

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Attachment: Version with Markings to Show Changes Made

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VERSION WITH MARKINGS SHOWING CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

1.   (Amended)   An image processing apparatus comprising:

means for receiving image data from a source of image data supply;

image processing means for performing necessary image processing on the received image data to produce output image data;

display means for displaying an image carried by the image data supplied from said source of image data supply;

designating means for designating at least one principal part of the image displayed by said display means; and

setting means for setting image processing conditions in accordance with <u>information about</u> said at least one principal part of the image designated by said designating means;

wherein said image processing means performs said necessary image processing under said image processing conditions set by said setting means.

8.   (Amended)   The image processing apparatus according to claim 2, wherein [said] extracting means automatically extracts [said] <u>a</u> region containing said at least one principal part in view of image continuity, in accordance with [said] <u>an</u> information about [said] at least one point in said at least one principal part designated by [said] <u>a</u> point designating means.

9. (Amended) The image processing apparatus according to claim 1, wherein said at least one principal part of said image comprises a plurality of principal parts and [said] a point designating means is of a type that designates one point in one of said plurality of principal parts and [said] extracting means automatically extracts at least one other principal part in said plurality of principal parts, based on [said] an information about said one point in said one principal part designated by said point designating means.

10. (Amended) The image processing apparatus according to claim 4, wherein [said] extracting means automatically extracts [the] a region containing the thus designated one principal part and [the] a region containing at least one other principal part in [said] a plurality of principal parts in view of [said] an image continuity, based on [said] an information about [said] one point in said one principal part designated by [said] a point designating means.

13. (Amended) The image processing apparatus according to claim 7, wherein said display means is of a type that also displays at least one of said at least one principal part having one point designated by said point designating means and said at least one principal part automatically extracted by said [extract] extracting means, and which further includes modifying means that modifies said at least one principal part displayed by said display means.

14. (Amended) The image processing apparatus according to claim 8, wherein said display means is of a type that also

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displays the region of said at least one principal part automatically extracted by said [extract] extracting means and which further includes modifying means that modifies the region containing said at least one principal part displayed by said display means.

15. (Amended) The image processing apparatus according to claim 9, wherein said display means is of a type that also displays at least one of said one principal part having one point designated by said point designating means, and at least one other principal part in said plurality of principal parts automatically extracted by said [extract] extracting means, and which further includes modifying means that modifies the region containing said at least one of said plurality of principal parts displayed by said display means.